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In re Application of
CHANTELOUP, Luc et al
Application No.: 09/065,041
PCT No.: PCT/FR96/01676
Int. Filing Date: 25 October 1996
Priority Date Claimed: 27 October 1995
Attorney Docket No.: 03806.0424
For: INTERMEDIARY COMPOUNDS FOR
THE HEMISYNTHESIS OF ...

DECISION ON

RENEWED REQUEST

UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 CFR §1.47(a)" filed 29 March 1999, requesting that the above-captioned application be allowed without the signature of one of the inventors, Jean-Pierre Robin.

BACKGROUND

On 28 January 1999, applicants were notified that their "Petition Filed Pursuant to 37 C.F.R. §1.47(a)" was dismissed because the petition did not set forth evidence that Mr. Le Pennec had any firsthand knowledge of the facts declared, nor does it demonstrate that Mr. Robin was presented with a complete copy of the application papers.

On 22 January 1999, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a declaration by Francoise Grenet, Director of Séripharm S.A., Technopole Université.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite petition fee required by 37 CFR 1.17(i); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known

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address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicants had previously satisfied items (1), (3) and (4) with their first petition.

Section 409.03(d), *Proof of Unavailability or Refusal*, of the Manual for Patent Examining Procedure states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. . . .

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. . . . Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Regarding item (2), in the renewed petition, Mr. Grenet, the Director of Séripharm S.A., Technopole Université claims that he "received the application papers, including the specification, Declaration and Power of Attorney, and Assignment, from Rhône-Poulenc Rohrer S.A. for signing by the named inventors." Grenet Decl. ¶ 6. Later, Mr. Grenet states that at a meeting with Mr. Robin, "I requested that he sign the application papers. Mr. Robin reviewed the application papers and informed me that he had made up his mind not to sign the application papers. Mr. Robin explained to me that his refusal was because of complex business difficulties between his company, Paclipharm, and Séripharm . . ." Grenet Decl. ¶ 9.

The declaration of Mr. Grenet lists all the facts and circumstances of Mr. Robin's refusal to sign the application and his reasons for the refusal. It also claims that Mr. Robin was presented with a complete copy of the application papers to review. Applicants' evidence satisfies item (2).

Accordingly, all requirements under 37 CFR 1.47(a) have been satisfied.

CONCLUSION

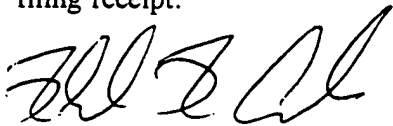
The petition under 37 CFR 1.47(a) is GRANTED.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c).

The application has an international filing date of 25 October 1996 under 35 U.S.C. 363, and a 35 U.S.C. 102(e) and 371(c) date of 27 April 1998.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the DO/EO/US for continued processing including issuance of a NOTIFICATION OF ACCEPTANCE (Form PCT/DO/EO/903) and filing receipt.



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